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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,360	06/13/2001	Steven E. Norby	20366-080400	8741
20350	7590	09/13/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NG, CHRISTINE Y	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/881,360	Applicant(s) NORBY, STEVEN E.	
	Examiner Christine Ng	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-9, 11-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see page 8, line 11 to page 11, line 16, filed June 29, 2006, with respect to the rejection(s) of claim(s) 1, 7 and 13 under 35 USC § 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretation of the previously applied reference.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-9, 11-15, 17, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,389,114 to Dowens et al.

Referring to claim 1, Dowens et al disclose a method for establishing a personal communication between an originating end (Figure 1, terminal 102 or 104) and a terminating end (Figure 1, terminal 106 or 108) of a communication system. Refer to Column 2, lines 17-33. The method comprises steps of:

Retrieving a first plurality of personal communication modes (Figure 4, voice or text) associated with the originating end. Each user of terminal 102 or 104 can

communicate through e-mail, telephone, pager, and Internet which utilize a voice or text mode of communication. Refer to Column 2, lines 17-42 and Column 6, lines 36-49.

Selecting one of the first plurality of personal communication modes, wherein the selecting step comprises:

Determining if a second plurality of personal communication modes (Figure 4, voice or text) associated with the terminating end comprises any personal communication modes compatible with the first plurality of personal communication modes. Each user of terminal 106 or 108 can communicate through e-mail, telephone, pager, and Internet which utilize a voice or text mode of communication. Refer to Column 2, lines 17-42 and Column 6, lines 36-49.

Automatically choosing a compatible personal communication mode from the first plurality of personal communication modes and the second plurality of personal communication modes. Terminal 102 calls terminal 108. If one of the terminals 102,108 is a voice terminal and the other terminal 102,108 is a text terminal, telecommunication relay device 116 performs voice-to-text or text-to-voice conversion. If both terminals are text or voice terminals, no conversion is required. If terminal 108 does not answer the call, relay device 116 can check if terminal 108 is logged on the Internet and support a communication via data network 120 and perform voice-to-text or text-to-voice conversion as needed. If terminal 108 does not answer the call, relay device 116 can also send a page or email to terminal 108. Refer to Column 2, line 52 to Column 3, line 21; Column 5, lines 11-31; and TABLE in Columns 5-8.

Indicating the compatible personal communication mode to the terminating end. Voice-to-text conversation, text-to-voice conversion, or no conversion is performed in order for the terminating end to receive the information. Refer to Column 2, line 52 to Column 3, line 21; Column 5, lines 11-31; and TABLE in Columns 5-8.

Wherein the compatible personal communication mode uses a communication transport method: text pager messaging (pager supporting text mode); electronic mail messaging (e-mail supporting text mode); voice over switched network communication (telephone supporting voice mode); and voice over Internet Protocol (Internet supporting voice mode). As shown in Figure 4, the system supports various communication transport methods including e-mail, telephone, pager, and Internet which utilize a voice or text communication mode. Refer to Column 2, lines 17-42 and Column 6, lines 36-49.

Referring to claim 2, Dowens et al disclose that the method further comprises the steps of:

Receiving the first plurality of personal communication modes (Figure 4, voice or text) from a first user associated with the originating end (Figure 1, terminal 102 or 104). Refer to the rejection of claim 1.

Receiving the second plurality of personal communication modes (Figure 4, voice or text) from a second user associated with the terminating end (Figure 1, terminal 106 or 108). Refer to the rejection of claim 1.

Referring to claim 3, Dowens et al disclose that the compatible personal communication mode couples communication between individuals (Figure 1, users of terminals 102,104,106,108). Refer to the rejection of claim 1.

Referring to claim 5, Dowens et al disclose in Figure 1 that the first plurality of compatible personal communication modes are stored in a database (database 122) that is remote to the originating end (terminal 102 or 104) or remote to the terminating end (terminal 106 or 108). Refer to Column 2, lines 17-33 and Column 6, lines 8-49.

Referring to claim 6, Dowens et al disclose in Figure 1 that the automatically choosing step is based, at least in part, upon input received from: an originating end (terminal 102 or 104) and a terminating end (terminal 106 or 108). Voice-to-text conversion, text-to-voice conversion, or no conversation is based on the type of calls between terminals 102-108. Refer to Column 2, line 52 to Column 3, line 21; Column 5, lines 11-31; and TABLE in Columns 5-8.

Referring to claim 7, Dowens et al disclose a method for automatically selecting a compatible personal communication mode between an originating end (Figure 1, terminal 102 or 104) and terminating end (Figure 1, terminal 106 or 108) of a communication system. Refer to Column 2, lines 17-33. The method comprises the steps of:

Receiving a first plurality of personal communication modes (Figure 4, voice or text) associated with an originating end. Each user of terminal 102 or 104 can communicate through e-mail, telephone, pager, and Internet which utilize a voice or text mode of communication. Refer to Column 2, lines 17-42 and Column 6, lines 36-49.

Receiving a second plurality of personal communication modes (Figure 4, voice or text) associated with a terminating end. Each user of terminal 106 or 108 can communicate through e-mail, telephone, pager, and Internet which utilize a voice or text mode of communication. Refer to Column 2, lines 17-42 and Column 6, lines 36-49.

Initiating a first personal communication between the originating end and terminating end. The controller 202 of telecommunication relay device 116 monitors a communication between a calling and called party until the communication is completed. Refer to Column 6, lines 1-6.

Selecting the compatible personal communication mode based upon the first plurality of personal communication modes and the second plurality of personal communication modes. Refer to the rejection of claim 1.

Initiating a second personal communication using the compatible personal communication mode. The controller 202 of telecommunication relay device 116 monitors a communication between a calling and called party until the communication is completed. Afterwards, controller 202 checks if the calling party would like to review additional messages or make another call. The calling party can then initiate a second communication. Refer to Column 6, lines 1-6.

Wherein the compatible personal communication mode uses a communication transport method: ... Refer to the rejection of claim 1.

Referring to claim 8, Dowens et al disclose in Figure 4 that the method further comprises the step of determining that a first personal communication mode for the first personal communication is unavailable. Figure 4 shows the contact preferences 406-

410 for each user. For example, user 412 should be contacted first by e-mail and then telephone if e-mail fails. Refer to Column 6, lines 36-49.

Referring to claim 9, Dowens et al disclose in Figure 1 that the selecting step comprises steps of negotiating the compatible personal communication mode with a first decision tree (TABLE in Columns 5-8) associated with the originating end (terminal 102 or 104) and a second decision tree (TABLE in Columns 5-8) associated with the terminating end (terminal 106 or 108). Refer to the rejection of claim 1.

Referring to claim 11, refer to the rejection of claim 3.

Referring to claim 12, refer to the rejection of claim 5.

Referring to claim 13, Dowens et al disclose in a personal communication system for establishing personal communication between a originating end (Figure 1, terminal 102 or 104) and a terminating end (Figure 1, terminal 106 or 108). Refer to Column 2, lines 17-33. The personal communication system comprises:

A first plurality of personal communication modes (Figure 4, voice or text) associated with the originating end. Each user of terminal 102 or 104 can communicate through e-mail, telephone, pager, and Internet which utilize a voice or text mode of communication. Refer to Column 2, lines 17-42 and Column 6, lines 36-49.

A second plurality of personal communication modes (Figure 4, voice or text) associated with the terminating end. Each user of terminal 106 or 108 can communicate through e-mail, telephone, pager, and Internet which utilize a voice or text mode of communication. Refer to Column 2, lines 17-42 and Column 6, lines 36-49.



A first personal communication mode that couples the originating end and the terminating end together. The controller 202 of telecommunication relay device 116 monitors a communication between a calling and called party until the communication is completed. Refer to Column 6, lines 1-6.

A decision mechanism (TABLE in Columns 5-8) for automatically choosing a second personal communication mode that is compatible with at least one of mode in each of the first plurality of personal communication modes and the second plurality of personal communication modes. Refer to the rejection of claim 1. The controller 202 of telecommunication relay device 116 monitors a communication between a calling and called party until the communication is completed. Afterwards, controller 202 checks if the calling party would like to review additional messages or make another call. The calling party can then initiate a second communication. Refer to Column 6, lines 1-6.

Wherein the compatible personal communication mode uses a communication transport method: ... Refer to the rejection of claim 1.

Referring to claim 14, refer to the rejection of claim 8.

Referring to claim 15, Dowens et al disclose in Figure 1 that the decision mechanism (TABLE in Columns 5-8) is in the terminating end (terminal 106 or 108). Voice-to-text conversion, text-to-voice conversion, or no conversation is based on the type of calls between terminals 102-108. Refer to Column 2, line 52 to Column 3, line 21; Column 5, lines 11-31; and TABLE in Columns 5-8.

Referring to claim 17, Dowens et al disclose that the first plurality of personal communication modes (Figure 4, voice or text) is sent from originating end (Figure 1,

terminal 102 or 104) to the terminating end (Figure 1, terminal 106 or 108) using the first personal communication mode. The controller 202 of telecommunication relay device 116 monitors a communication between a calling and called party until the communication is completed, using the first communication mode. Refer to Column 6, lines 1-6.

Referring to claim 18, Dowens et al disclose that that the second personal communication mode is different from the first personal communication mode. The controller 202 of telecommunication relay device 116 monitors a communication between a calling and called party until the communication is completed. Afterwards, controller 202 checks if the calling party would like to review additional messages or make another call. Refer to Column 6, lines 1-6. The next call can be of a different communication mode according to the TABLE in Columns 5-8.

Referring to claim 20, refer to the rejection of claim 5.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,389,114 to Dowens et al in view of U.S. Publication No. 2002/0018487 to Chen et al.

Dowens et al do not disclose a query menu presented to a user associated with the originating end, wherein presentment of the query menu is performed in response to the first communication mode being unavailable.


Chen et al discloses in Figure 2 a mobile station 205 that includes an application programming interface API 210 that allows “a programmer to change the communication protocol used by an apparatus by selecting an option in a simple menu of options” (Section 0017) in order to “provide timely and efficient adaptation to meet the ever-changing needs of the wireless communication field” (Section 0009). Refer to Section 0040. Although Chen et al do not state that the menu is presented when the first communication mode becomes unavailable, this would allow the user to experience uninterrupted service by immediately switching to a functional mode. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a query menu presented to a user associated with the originating end, wherein presentment of the query menu is performed in response to the first communication mode being unavailable, the motivation being so that the wireless system can be more flexible and adaptable by accommodating a variety of communication protocols each with its own unique system requirements and allowing the mobile station to be used in different environments as it moves from one location to another. Refer to Sections 0003-0011.

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Ng whose telephone number is (571) 272-3124. The examiner can normally be reached on M-F; 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

C. Ng   
September 6, 2006



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